

### **REMARKS/ARGUMENTS**

The office action of June 18, 2003 has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested.

Claims 1-20 were originally presented for examination. Claims 2, 9, 11, 18 and 20 have been canceled without prejudice or disclaimer and new claims 21-22 have been added. Claims 1, 3-8, 10, 12-17, 19 and 21-22 thus remain pending after entry of the present amendments.

#### ***Rejections Under 35 U.S.C. § 102***

Claims 1, 3-7, 10, and 12-16 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kung *et al.* (U.S. Pat. No. 6,570,583 B1, hereinafter Kung). Applicants respectfully traverse this rejection for at least the following reasons.

In order to reject a claim as anticipated under 35 U.S.C. § 102, a single prior art reference must teach every aspect of the claimed invention. MPEP § 706.02. Independent claim 1 has been amended to include the recitations from canceled dependent claim 2. Canceled dependent claim 2 was rejected under 35 U.S.C. § 103(a) over Kung in view of Williams *et al.* Thus, amended claim 1 is not anticipated by Kung alone. The obviousness rejection of canceled claim 2, as it now applies to amended claim 1, is addressed below.

Claims 3-7 are allowable for at least the same reasons as independent base claim 1.

Amended independent claim 10 recites, *inter alia*, "wherein first and second user input controls are located on the back portion of the device, and wherein the display screen is located on the front of the device." As with amended claim 1, Kung does not teach or suggest this aspect of the claim. Instead, Kung places the controls on the same side of the device as the display.

Claims 12-16 are allowable for at least the same reasons as independent base claim 10.

Claim 20 has been canceled.

#### ***Rejections Under 35 U.S.C. § 103***

Claims 9 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kung. Claims 9 and 18 have been canceled, rendering this rejection moot.

Claims 2, 8, 11, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kung in view of Williams *et al.* (U.S. Pat. No. 5,542,138, hereinafter Williams). Claims 2 and 11 have been canceled. However, the rejection of canceled claim 2 now applies to amended claim 1, which has been amended to incorporate the limitations of canceled claim 2, so the §103(a) rejection of claim 2 will be addressed at this time.

In order to reject a claim as obvious under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. See MPEP § 706.02 (j); *In re Vaack*, 947 F.2d 488 (Fed. Cir. 1991).

Kung describes a zoom-enabled handheld device that has a zoom control device for generating a zoom control signal. A display program, held in memory, will change the font size of displayed text or icons according to the zoom control signal. Kung, Title and Abstract. However, the Kung device, as discussed above, places the zoom and panning controls on the same side of the device as the display screen.

Williams, on the other hand, describes a remote control unit for a hospital bed, not even remotely related to handheld devices such as are described in Kung. In addition, Williams does not provide a zooming or panning control, or any other control on a back side of the remote control device. To the contrary, the Williams remote control device must be *opened* in order to expose the controls referred to by the Office Action.

Furthermore, the Office Action does not provide any suggestion or motivation to combine the two references. The Federal Circuit has repeatedly stated that the limitations of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and that the Patent Office should *rigorously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. *Id.* (emphasis added). Thus, based on the above arguments, Applicants respectfully submit that there is no motivation or suggestion to combine Kung, which describes a zoom-enabled handheld device, with Williams, which describes a remote

control device. Should the Office maintain this rejection, the examiner is respectfully requested to provide a suggestion or motivation within the references themselves, or provide evidence of the level of knowledge of one of ordinary skill in the art, that would support such a combination.

In addition, even if Kung were combined with Williams, the combination does not teach or suggest placing first and second user input controls on the housing on the back of the device, and placing the display screen on the front of the device, because the remote control device in Williams must be opened in order to expose the controls. That is, the controls in the Williams device are internal to the device in its normal mode of operation. Thus, the rejection of claim 2, now in the form of amended claim 1, is respectfully traversed.

Claims 8 and 17 are allowable for at least the same reasons as their respective base claims.

Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kung in view of Williams and further in view of Wang (U.S. Pat. No. 5,771,038, hereinafter Wang). Applicants respectfully submit that claim 19 is allowable for similar reasons as claim 1, namely, that Kung cannot properly be combined with Williams and, even if combined, the combination does not teach or suggest all the claim limitations. Namely, the combination at least does not teach or suggest "a display screen on a front side of the housing; a first touch pad attached to a back side of the housing; and a second touch pad attached to the back side of the housing;..." as recited by the claim.

#### *New Claims*

New claims 21 and 22 have been added. Claims 21 and 22 are supported by the specification as originally filed, at least at paragraph 27.

**CONCLUSION**

Based on the aforementioned claims 1, 3-8, 10, 12-17, 19 and 21-22 are in condition for allowance. Therefore, it is respectfully requested that the subject application be reconsidered and passed to issue at the Examiner's earliest possible convenience.

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

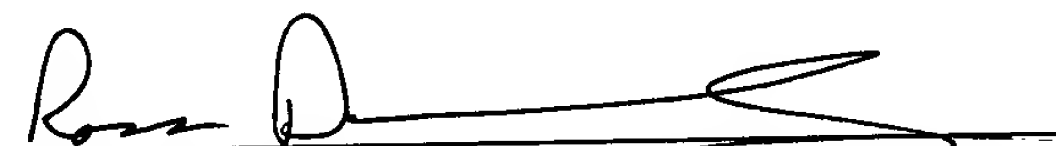
All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated this 29 day of Aug., 2003

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